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| 10/672,502   | 09/26/2003  | J. Phillips L. Johnston | 7334-001            | 8683             |
| 4678 7590 01/05/2009<br>MACCORD MASON PLLC<br>300 N. GREENE STREET, SUITE 1600<br>P. O. BOX 2974<br>GREENSBORO, NC 27402 |             |                         |                     |                  |
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| LONG, PONYA M  |             |                         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/672,502

**Applicant(s)**

JOHNSTON, J. PHILLIPS L.

**Examiner**

FONYA LONG

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5 and 6 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3, 5 and 6 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This communication is a Final Office Action on the merits in response to communications filed on October 20, 2008. Claims 1 and 2 have been amended. Claim 4 has been canceled. Claim 6 has been added. Claims 1-3 and 5-6 are currently pending and have been addressed below.

### ***Response to Amendment***

1. Applicant's amendments to the claims are sufficient to overcome the 112 2<sup>nd</sup> rejections set forth in the previous office action.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sprague (1990) in view of Rackman (5,903,646) and in further view of Stafford Frey Cooper (April 15, 2001; herein known as "Stafford").

**As per Claims 1 and 2**, Sprague discloses a system and method for providing automated legal audits of a business (Page 774, discloses an automated legal audit used to analyze the current status of a business) comprising: a data processing system having at least one computer (Page 775, discloses the ability to use the system from

multiple computers or terminals) and a user interface which is defined as part of the design of a computer or other device or program that accepts commands from and returns information to the user by *Encarta® World English Dictionary [North American Edition]* © & (P)2007 Microsoft Corporation. All rights reserved. Developed for Microsoft by Bloomsbury Publishing Plc. (Page 777, via the online system searching and retrieving statutory and case law based upon a boolean search entered by the user and providing the documents to the user), with software running on the computer for providing at least one user with information and advice relating to a legal audit (Page 775, discloses software considerations), and wherein the data processing system further includes a database of the records having automated categorization of records in an index and/or a spreadsheet (Page 777, discloses a stored indexed database of applicable statutory and case law), wherein the index and/or the spreadsheet are searchable by an authorized user of the system (Page 777, discloses a hypertext-based procedure to search the stored database);

reviewing by the system legal documents relating to a company's business, wherein said documents are contained in electronic format in the data processing system or database (Page 775, discloses the system having a hypertext feature which can automatically implement itself within on-line and stored information which is accessed by the user to allow the user to more effectively review that information); and

advising by the system the board of directors and corporate officers and managers, thereby providing the company advance notice in order to take action(s) to minimize and/or to avoid litigation and to reduce legal costs for the company (Page 773,

discloses generating a report which identifies and details the legal issues which should be addressed in order to comply with existing laws and regulations in order to avoid potential legal problems and (Page 774) reviewing the report with the client).

Sprague discloses the claimed invention except for the system reviewing legal documents and the system advising the board of directors and corporate officers and managers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a system perform the reviewing of legal documents and advise the board of directors and corporate officers and managers, since it have been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

However, Sprague fails to explicitly disclose providing information selected from a group consisting of records of the company's business transactions, minutes of board of directors meetings, contractual agreements, licensing agreements, supplier and vendor agreements, purchase orders, partnership agreements, communications with competitors, intellectual property documents and registrations; reducing the legal documents to summary form; and overseeing the organization of all important legal documents.

Rackman (5,903,646) discloses an access control system for litigation document production concept of reducing by the system the legal documents to summary form in business language wherein said business language includes layman terms understood

by corporate officers, directors, and managers (Col. 8, Lines 10-14, discloses summarizing legal documents).

Examiner asserts that the documents having business language is considered non-functional descriptive material. The form of language used in the documents does not change the function of claimed invention. Examiner asserts that the Sprague and Rackman combination is fully capable of having the summarized documents in business language form.

Therefore, from the teaching of Rackman, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the automated legal audit system of Sprague to include reducing by the system the legal documents to summary form as taught by Rackman in order to aid in reviewing documents.

Stafford discloses a legal audit with the concept of providing information selected from a group consisting of records of company's business transactions, minutes of board of directors meetings, contractual agreements, licensing agreements, supplier and vendor agreements, purchase orders, partnership agreements, communications with competitors, intellectual property documents and registrations; and overseeing the organization of all important legal documents (discloses reviewing all significant business transactions, minutes and resolutions from board meetings, contracts, leases, and other agreements); and overseeing the organization of all important legal documents (discloses checking the status of a company's state license and registration, making sure the periodic filings with government agencies been taken care of on schedule).

Therefore, from the teaching of Stafford, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the automated legal audit system of Sprague to include providing information selected from a group consisting of records of the company's business transactions, minutes of board of directors meetings, contractual agreements, licensing agreements, supplier and vendor agreements, purchase orders, partnership agreements, communications with competitors, intellectual property documents and registrations; and overseeing the organization of all important legal documents as taught by Stafford in order to ensure the company is in compliance and maintains compliance with the applicable laws.

**As per Claim 3**, the Sprague and Rackman combination discloses the claimed invention as applied to Claim 2, above. However, the combination fails to explicitly disclose corporate documents including bylaws, minutes of meetings for the board of directors, other corporate officers, and/or managers.

Stafford discloses a legal audit with the concept of corporate documents including bylaws, minutes of meetings for the board of directors, other corporate officers, and/or managers (discloses reviewing corporate documents such as minutes and resolutions from board meetings).

Therefore, from the teaching of Stafford, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Sprague and Rackman combination to include corporate documents including bylaws, minutes of meetings for the board of directors, other corporate officers, and/or managers as taught

by Stafford in order to ensure the company is in compliance and maintains compliance with the applicable laws.

**As per Claim 5**, Sprague discloses advising regarding select issues, matters, and areas of potential litigation (Page 773-774, discloses advising the client of the basic legal issues applicable to the client's business, and providing recommended courses of action).

**As per Claim 6**, Sprague discloses the claimed invention as applied to Claim 2, above. However, Sprague fails to explicitly disclose removing, deleting, or otherwise purging information that might result in legal action being taken against the business.

Rackman discloses an access control system for litigation document production with the concept of removing, deleting, or otherwise purging from the data processing system information that might result in legal action being taken against the business (Col. 1, Line 60-Col. 2, Line 21, discloses removing information via redaction wherein information is removed from a document).

Therefore, from the teaching of Rackman, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the automated legal audit system of Sprague to include removing, deleting, or otherwise purging information that might result in legal action being taken against the business as taught by Rackman in order to aid in controlling access to restricted information.



***Response to Arguments***

4. Applicant's arguments filed October 20, 2008 have been fully considered but they are not persuasive.

**As per Claim 2**, Applicant argues the Sprague and Stafford combination fails to disclose overseeing the organization of all important legal documents and advising the board of directors and corporate officers and managers. Examiner respectfully disagrees. Stafford discloses overseeing the organization of all important legal documents by reviewing all significant business transactions, contracts, leases, and other agreements; and checking the status of a company's state license and registration, making sure the periodic filings with government agencies been taken care of on schedule. Sprague discloses advising the board of directors and corporate officers and managers by generating a report which identifies and details the legal issues which should be addressed and reviewing the report with the client (Pages 773-774). Examiner asserts that the board of directors and corporate officers and managers being advised is considered non-functional descriptive material. The fact that the persons being advised are the board of directors and corporate officers and managers does not change the claimed invention. Examiner asserts Sprague is fully capable of advising the board of directors and corporate officers and managers.

**As per Claims 1, 3, and 5**, Applicant's arguments fail to comply with 37 CFR 1.111 (b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **FONYA LONG** whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thur 7:30am-6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./  
Examiner, Art Unit 3689

/Janice A. Mooneyham/  
Supervisory Patent Examiner, Art Unit 3689